



101/58
3/3/03 PATENT
Attorney Docket No. 02481.1742

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)

E. UHLMANN et al.)

Application No.: 09/835,370)

Filed: April 17, 2001)

For: POLYAMIDE NUCLEIC ACID)
DERIVATIVES AND AGENTS AND)
PROCESSES FOR PREPARING THEM)

Group Art Unit: 163

Examiner: SIEW

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Assistant Commissioner for Patents
Washington, D.C. 20231

RESPONSE TO RESTRICTION/ELECTION OF SPECIES REQUIREMENT

Sir:

This paper is being filed in response to a Restriction/Election of Species Requirement dated September 17, 2002. It is accompanied by a Petition for Extension of Time and the fee required to extend the shortened statutory period for response up to **February 19, 2003** (February 17, 2003, being a national holiday, and the PTO being closed on February 18).

I. *Restriction Requirement*

In a Restriction Requirement dated September 17, 2002, the Office required restriction under 35 U.S.C. § 121 between the claims of Group I (claims 1-15, 20-23, and 31-85), the claims of Group II (claims 16-19), and the claims of Group III (claims 24-30). Applicants provisionally elect to prosecute Group I, claims 1-15, 20-23, and 31-85, drawn to a phosphorylated polyamide nucleic acid structure, *with* traverse.

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It is respectfully submitted that the subject matter of all of claims 1-85 is sufficiently related that a thorough search of the subject matter of any one group of claims would encompass a search for the subject matter of the remaining claims. In particular, because the claims of Group I are related to those of Groups II and III as products (Group I) and methods of using (Group II) and methods of making (Group III) them, a thorough search of the products of Group I would necessarily encompass a search for methods of making and methods of using the products of Groups II and III, respectively. Thus, a search and examination of the non-elected claims with the claims of Group I would not place a serious additional burden on the Examiner.

MPEP § 803 states that "if the search and examination of the entire application can be made without serious burden, the examiner must examine it on the merits" (emphasis added herein by Applicants). It is respectfully submitted that this policy should apply in the present application in order to avoid unnecessary delay and expense to Applicants and duplicative examination by the Patent Office.

In view of the above remarks, Applicants respectfully request withdrawal of the Restriction Requirement. In the event that the Office does not withdraw the Restriction Requirement, Applicants reserve the right to prosecute the non-elected claims in divisional or continuation applications.

Further, if the Office does not find Applicants' comments convincing, Applicants respectfully submit that the non-elected method claims of Groups II and III should be rejoined with the product claims of Group I once one or more product claims are found to be allowable. In response to *In re Ochiai* and *In re Brouwer*, the Commissioner set forth guidelines for treatment of non-elected process claims. See the Official Gazette, 1184 OG 88 (March 26,

1996). These guidelines have been incorporated into MPEP § 821.04. Under these PTO guidelines, "rejoinder practice" applies to Applicants who have elected claims to a product over claims to a process in compliance with a Restriction Requirement. When it is established that a product claim is allowable, withdrawn process claims that depend from, or otherwise include all the limitations of, the allowable product claim must be rejoined. Applicants respectfully submit that this procedure applies to the present claims.

II. *Election of Species Requirement*

In an Election of Species Requirement issued by the Office with the Restriction Requirement, the Office requires Applicants to elect a single chemical species for initial examination in this application. In response, Applicants elect the polyamide nucleic acid disclosed in Example 12 as PNA 11, *with* traverse. The elected PNA is represented by the following text formula: biotin-p-{g(oeg)-gt atg gga tat}-hex. The elected PNA is represented by the chemical formula attached to this Response.

As with the requirement for restriction, Applicants respectfully submit that examination of the entire scope of the elected claims would not be a serious burden on the Examiner because all of the species encompassed by the claims are chemically related and thus could be examined by consulting the same class and subclass in the PTO archives. For at least this reason, Applicants request reconsideration and withdrawal of the Election of Species Requirement.

If the Office chooses, however, to maintain the Election of Species Requirement, Applicants expect that the Office, if the elected species is found allowable, to continue to examine the full scope of the claims to the extent necessary to determine the patentability of

these pending claims. That is, Applicants request that, upon indication of allowable subject matter, the Office extend the search to a reasonable number of non-elected species, as is the duty according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

III. *Conclusion*

Early and favorable examination is requested. If the Office believes anything further is necessary in order to place this application in condition for allowance, Applicants request that their undersigned representatives be contacted at the telephone numbers or e-mail addresses provided below.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Attachment:

Chemical formula of PNA 11 (3 pages)

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